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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

Robert J. Lang, Noboru Miyajima,  
Manuel Sirgo, Nicola Bandoni,  
Toshikazu Kawasaki, and Jason Ku,

Plaintiffs,

v.

Sarah Morris,

Defendant.

Case No.: 11 CV 8821  
(BSJ)(AJP)

**MEMORANDUM OF LAW IN OPPOSITION TO  
DEFENDANT'S MOTION FOR SUMMARY JUDGMENT**

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## PRELIMINARY STATEMENT

Robert J. Lang (“Lang”), Noboru Miyajima (“Miyajima”), and Jason Ku (collectively, “Plaintiffs” or “Origami Artists”) sue artist Sarah Morris (“Defendant” or “Morris”) for copyright infringement. Plaintiffs and Defendant submitted mutual motions for summary judgment on June 29, 2012.

Defendant has addressed the arguments in Dkt. 34 and Dkt. 63 to all of the claims in Plaintiffs’ Proposed First Amended Complaint. However, the Court has yet to rule on Plaintiffs’ Motion for Leave to File a First Amended (Dkt. 26) and Judge Peck’s May 29, 2012 Minute Order indicated that only the claims in the original complaint, filed on December 5, 2012, were at issue for the mutual summary judgment motions.

## INTRODUCTION

Defendant filed a motion for summary judgment on June 26, 2012, asserting that Plaintiffs have failed to establish ownership of crease patterns authored by Plaintiff Robert Lang (“Lang” or “Dr. Lang”) that were published in his book *Origami Design Secrets: Mathematical Methods for an Ancient Art* (“*Origami Design Secrets*”); that most of Plaintiffs’ claims are time-barred; and that Ms. Morris made fair use of Plaintiffs’ crease patterns.

## ARGUMENT

### **I. Lang Has Standing As Beneficial Owner of the Copyright in *Origami Design Secrets*.**

The following facts are undisputed: Seven of Dr. Lang’s nine crease patterns at issue in the Complaint (Dkt. 1) appeared in his book *Origami Design Secrets*, first published by A K Peters, Ltd. (“A K Peters”) in 2003. Dr. Lang was the sole author and original owner of the copyright in the book, which took him about 18 months of full-time work to complete. (Declaration of Robert J. Lang in Opposition to the Motion for Summary Judgment (“Lang Opp. Decl.”), ¶ 7.) Under the terms of Dr. Lang’s April 2002 publication agreement with A K Peters (“Agreement”), he parted with legal title to the copyright in *Origami Design Secrets* in exchange for percentage of the royalties based on sales. (*Id.*, Ex. B.) A K Peters registered the book’s copyright within 90 days of its publication. (*See id.*, Ex. C.)

Beyond these facts, this dispute has taken a circuitous route regarding Dr. Lang's standing to sue for infringement of the crease patterns published in *Origami Design Secrets*, only to land back at the feet of an unassailable truth: Lang—as an author who parted with legal title to the copyright in exchange for royalties—is the beneficial owner of the copyright in *Origami Design Secrets*. Under § 501(b) of the Copyright Act, the Court should determine that Dr. Lang had standing to bring this action for infringement.

#### **A. Beneficial Ownership Under the Copyright Act**

Until the passage of the 1976 Copyright Act, standing to sue for infringement was limited to the “proprietor” of a copyright. *Cortner v. Israel*, 732 F.2d 267, 271 (2d Cir. 1984). Under the 1909 Copyright Act, Courts granted equitable (“beneficial”) owners standing to sue third parties subject to two conditions: (1) that the legal owner of the copyright had refused a demand to sue, and (2) that the legal owner was joined as a plaintiff. The 1976 Copyright Act codified the beneficial owner's standing to sue without carrying forward these preconditions. *See id.* (citing 3 *Nimmer on Copyright* § 12.02).

Section 501(b) of the 1976 Act provides: the “legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it.” 17 U.S.C. § 501(b). The Act does not define “beneficial owner,” but the legislative history accompanying the Act states: “A ‘beneficial owner’ for this purpose would include, for example, an author who had parted with legal title to the copyright in exchange for percentage royalties based on sales or license fees.” H.R. Rep. No. 1476, 94th Cong., 2d Sess. 159, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5775 (cited by *Cortner v. Israel*, 732 F. 2d at 271).

Under the 1976 Copyright Act, standing to sue third parties as a beneficial owner is not conditioned on the legal owner's declining to file suit or being joined in the action; it is sufficient that an author have retained a right to receive royalties. *See, e.g., Kamakazi Music Corp. v. Robbins Music Corp.*, 534 F.Supp. 69, 74 (S.D.N.Y. 1982) (recognizing songwriter as proper plaintiff under § 501(b) “since he transferred legal

title to the copyrights in exchange for a percent of the royalties based on sales of license fees”); *Silberman v. Innovation Luggage, Inc.*, 2003 WL 1787123, at \*7 n. 5 (S.D.N.Y. Apr. 3, 2003) (noting that even if plaintiff was no longer the legal owner of the right at issue, “he could still have standing to sue as beneficial owner of that right, based on royalties received or other indicia of control”); *Authors Guild v. Google, Inc.*, 2012 WL 1951790, at \*5 n.4 (S.D.N.Y. May 31, 2012) (“Individuals who receive royalties retain standing to sue for copyright infringement.”) (quoting *Cortner v. Israel*, 732 F.2d 267, 271 (2d Cir. 1984)..

Defendant would read two additional conditions into the Act: (1) the beneficial owner must receive the “permission” of the legal owner, and (2) the beneficial owner “must be more than a mere royalty recipient.” (Dkt. 53 at pg. 5.) These contentions fly in the face of the plain language of the statute, the legislative history, and the case law cited above. *See also Model Jury Instructions: Copyright, Trademark, and Trade Dress Litigation*, ABA Publishing (2008), at pg. 7 (“To be a beneficial owner of a copyright, plaintiff must prove that she authored the work but then transferred title to the work to another while retaining a right to royalties based on sales.”). As discussed at note 2, *infra*, Lang retained more than a bare right to royalties, but this is not a condition of standing as beneficial owner.

Defendant’s reliance on *Manning v. Miller Music Corp.*, 174 F. Supp. 192 (S.D.N.Y. 1959), is misplaced. That case was decided before the 1976 Copyright Act was enacted and thus does not bear on how the Court should interpret the current § 501(b). The case of *Hearn v. Meyer*, 664 F. Supp. 832 (S.D.N.Y. 1987), also cited by Defendant, is inapposite. In *Hearn*, the court denied the plaintiff author standing as a beneficial owner because, unlike here, the author had *not* retained a right to royalties, only the possibility of a reverter. *Id.* at 841.

As the Second Circuit noted in *Cortner*, “[w]hen a[n author] assigns copyright title to a publisher in exchange for the payment of royalties, an equitable trust relationship is established between the two parties which gives the [author] standing to sue for infringement of that copyright.” *Cortner v. Israel*, 732 F.2d 267, 271 (2d Cir.



1984). The example Congress provided of a beneficial owner under § 501(b)—“an author who ha[s] parted with legal title to the copyright in exchange for percentage royalties based on sales” — describes Dr. Lang precisely.

**B. Lang’s Publication Agreement with A K Peters**

Under the terms of Dr. Lang’s 2002 agreement with his publisher, A K Peters, he parted with legal title to the book he was to author on the subject of “Origami Design and Mathematics,” later titled *Origami Design Secrets: Mathematical Secrets of an Ancient Art*, in exchange for percentage royalties based on sales of the work. (See Lang Opp. Decl., Ex. B.)

Under Clause B of the Agreement, Lang agreed “to permit the Publisher to copyright . . . said Work in the Publisher’s name . . . and to execute all documents necessary to enable the Publisher to secure the original copyright and any renewals of copyright of the Work.” In consideration thereof, A K Peters agreed to pay Lang “royalties based on a percentage of the [net] amount received on all copies of the Work sold,” as described in Clause C.<sup>1</sup> Since the first publication of *Origami Design Secrets* in 2003, Dr. Lang has received royalty payments based on sales of the book from A K Peters and its successor in interest Taylor & Francis, Inc. (Lang Opp. Decl., ¶ 5.) There is no dispute as to the validity and effect of the Agreement action.

**II. LANG’S STANDING UNDER § 501(B) DOES NOT IMPLICATE THE REQUIREMENT OF A WRITING UNDER § 204(A)**

Opposing counsel has argued strenuously that an agreement between Taylor & Francis, Inc. and Dr. Lang titled “Assignment of Copyright” should be excluded as untimely and is ineffective to provide Dr. Lang standing in this matter. Plaintiffs do not concede the first point, but contend that although Dr. Lang is not currently in possession of a written transfer agreement validating his prior oral agreement with A K

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<sup>1</sup> In addition to royalties, Dr. Lang retained: the right to draw on and refer to material contained in the Work, in preparing articles for publication in professional and scholarly journals and papers for delivery at professional meetings (Clause J); the right to no-cost and discounted copies of the Work; and the right to a return of rights upon request, in the event the Publisher takes the Work out of print (Clause M).

Peters,<sup>2</sup> this is not required. Lang has standing as a beneficial owner under § 501(b).

Dr. Lang, as an author who parted with legal title to the copyright in exchange for percentage royalties based on sales, is the exemplary “beneficial owner” according to the legislative history of § 501(b). There is no dispute as to the underlying facts on which the Court should base this finding, and the supporting evidence has long been before Defendant. The copyright registration for *Origami Design Secrets* was attached to the Complaint and the Proposed First Amended Complaint, as well as to the complaint Plaintiffs filed in the Northern District of California in March 2011. Lang’s Agreement with A K Peters was produced in discovery on May 2, 2012, over four months ago. (Supp. Jacobson Decl., Ex. D, LANG00052-53), and Lang was deposed by opposing counsel about the Agreement on June 5, 2012. (Supp. Jacobson Decl., Ex. A, Lang Depo. 206:10-217:25).

Plaintiffs’ argument is also timely. In *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153 (S.D.N.Y. 1986), the defendants contended that the plaintiffs had not sufficiently alleged or proven the existence of a present beneficial interest in the work at issue based on the subsequent chain of ownership. The plaintiffs, however, attached “the original contract in which they retained numerous rights in [the work at issue]” to their affidavit

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<sup>2</sup> Dr. Lang spent over a year and a half working full-time on *Origami Design Secrets*. (Lang Decl., ¶ 7.) He wrote every word and created every graphic in the book (Lang Depo., 220:14-16.), and he is passionate about what he created. He chose a small publishing house run by a husband and wife team, and communicated regularly with co-owner Klaus Peters. (*Id.*, ¶ 13.)

Dr. Lang intended to retain, and, based on various interactions with Klaus Peters, believed he had retained, an enduring right to create noncompeting derivative works from the graphic images he created and published in *Origami Design Secrets*, as well as a right to take action regarding infringements of these images. (*Id.*, ¶ 14.) He did not realize this verbal understanding would be unenforceable unless reduced to writing. (*Id.*)

Nevertheless, the conduct of both Dr. Lang and A K Peters since 2003 has been consistent with the existence of such an agreement. (*Id.*) Dr. Lang periodically updated Mr. Peters on his efforts to curb infringement of his derivative work right, but these activities were undertaken solely at Dr. Lang’s expense and effort. (Lang Decl., ¶ 16.) Mr. Peters requested to be kept him informed, but took no action on behalf of A K Peters. (*Id.*) Nor was A K Peters a party to the settlement agreement Dr. Lang reached in 2010 with an infringer of *Origami Design Secrets*. (*Id.*)

in opposition. *Id.* at 1157. The district court determined this was “sufficient to defeat a motion for summary judgment.” *Id.*

Defendant’s objection to the timeliness of Dr. Lang’s standing argument is further undermined by the fact that courts may raise a standing question at any time *sua sponte*. (See, e.g. *United States v. Hays*, 515 U.S. 737, 742 (1995)). Plaintiffs’ counsel also alerted Defendant’s counsel on July 30<sup>th</sup> about the basis for Lang’s standing as beneficial owner, three weeks before Defendant filed her Supplemental Memorandum of Law in Support of the Motion for Summary Judgment (Dkt. 63). (Supp. Jacobson Decl., Ex. E.)

Denying Dr. Lang standing would be contrary to the intention of Congress to protect authors similarly situated; this intention is discernible in the plain wording of § 501(b) and in the example of beneficial owner in the legislative history of the 1976 Copyright Act. Dr. Lang has standing, as a beneficial owner of the copyright to *Origami Design Secrets*, to bring an action for infringement of the copyright to the work.

### **III. PLAINTIFFS’ CLAIMS ARE NOT BARRED BY THE STATUTE OF LIMITATIONS**

The Court should apply the discovery rule in calculating the relevant statute of limitations time frame. As a separate matter, the Court should equitably toll the statute of limitations for the reasons described below. Plaintiffs first address the question of which dates should be used for calculating whether the claims are timely.

#### **A. Dates of Sale and Dates of Infringement Are Not Necessarily Equivalent.**

In most cases, Ms. Morris created multiple Infringing Works from each of Plaintiffs’ copyrighted works. In arguing that Plaintiffs’ claims are time-barred, Ms. Morris has conflated the dates she sold individual Infringing Works with the latest possible date of infringement. The logic appears to be that the absence of a completed sale of an Infringing Work absolves her of potential liability, which is untrue. The Copyright Act gives a copyright owner the exclusive right to distribute and publicly display copies of the work, 17 U.S.C. § 106(4), (5) — which includes derivative works, defined to include “any . . . form in which a work may be recast, transformed, or adapted.” 17 U.S.C. § 101. The dates of sale Ms. Morris provides (see chart at page 2 of

Dkt. 53-1), are relevant for calculation of damages, but are not necessarily the latest relevant date regarding infringement of the Plaintiffs' respective works.

Ms. Morris infringed the copyrights in the works through publishing the Infringing Works (*see* 17 U.S.C. § 101, defining publication as "the distribution of copies . . . of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending") and by publicly displaying the Infringing Works (*see id.*, "to perform or displaying a work 'publicly' means: (1) to perform or display it at a place open to the public or at any place where a substantial number of persons . . . is gathered . . ."—such as an exhibition at a gallery.

Because "[e]ach act of infringement is a distinct harm giving rise to an independent claim for relief," *Stone v. Williams*, 970 F.2d 1043, 1049 (2d Cir. 1992), it is only necessary that one of the infringements of each crease pattern have taken place within the relevant time frame for the Plaintiffs to sustain the claim.

Various paintings from Ms. Morris's Origami series have been included in more than a dozen exhibitions in which she had active involvement, such as selecting the works to be displayed (including at times works she had already sold), arranging for transportation of the works to the site, and participating in events related to the exhibition. (Supp. Jacobson Decl., Ex. F, email about arranging for the loan of Rhino Beetle for a 2009 Exhibition, though it had been sold to a collector in 2008, DO0900 .)

When Ms. Morris acted in concert with others to exhibit a painting (Angel) infringing Mr. Ku's Harpy crease pattern and a painting (Rockhopper) infringing Mr. Miyajima's Penguin crease pattern in May 2009 (Supp. Jacobson Decl., Ex. G, DO02121-2124) these were distinct instances of copyright infringement falling within three years prior to filing of the New York Complaint. In addition to public exhibitions, Ms. Morris authorized the publication of images of Infringed Works in print and online periodicals. (Supp. Jacobson Decl., Ex. H, email showing invoice for 1000 GBP to Sarah Morris's company Radial Matrix for the use of Angel on the cover of Wallpaper\* Magazine, 2009. DO01214). Royalties were apparently collected on behalf of Ms. Morris for secondary market sales of Infringing Works (further distributions, from which she profited.)

(Supp. Jacobson Decl., Exs. I and J, D01061, 1877.)

Any claims arising out of infringements within the three-year period preceding the filing of suit are actionable, "apart from any tolling effect." *Roberts v. Keith*, 2006 WL 547252, at \*4 (S.D.N.Y. Mar. 7, 2006.) "If such infringement occurred within three years prior to the filing, the action will not be barred even if prior infringements by the same party as to the same work are barred because they occurred more than three years previously." *Lennon v. Seaman*, 63 F.Supp. 2d 428, 443 (S.D.N.Y. 1999) (quoting 3 Nimmer §12.05[A]).

**B. The Court Should Apply the Discovery Rule in Calculating the Statute of Limitations.**

Claims for copyright infringement must be brought within three years of accrual (see 17 U.S.C. § 507(b)). The Copyright Act is silent as to the definition of accrual, but courts generally interpret the term to mean that the statute of limitations clock starts to run from the time a reasonably diligent plaintiff discovered the infringement ("the discovery rule"). *Zalewski v. T.P. Builders*, 2011 WL 3328549 (N.D.N.Y. Aug. 2, 2011). In *Zalewski*,

the parties ardently dispute the scope of the term "accrued" governed by the "discovery rule," such that a copyright claim begins to accrue when the plaintiff "knows or has reason to know of the injury upon which the claim is premised." *Merchant*, 92 F.3d at 56 (citation omitted). Defendants, on the other hand, contend that the "injury rule" applies, whereby a claim accrues at the time of the infringement. Defendants' contention is based principally on the Supreme Court's decision in *TRW Inc. v. Andrews*, 534 U.S. 19 (2001), and derivatively on a line of decisions that have emerged from the Southern District of New York.

*Id.* at \*5.

The *Zalewski* court upheld use of the discovery rule, finding that

"as to civil copyright claims, the discovery rule best comports with the text and structure of the Copyright Act. [Citation omitted.] Specifically, a comparison of the Act's criminal limitations period, which begins to run when the "cause of action arose" and therefore embodies the injury rule, 17 U.S.C. § 507(a), with the Act's civil limitations period, which begins to run when "the claim accrued," *id.* § 507(b), dictates that the term "accrued" carries a meaning different from "arose" and therefore embodies a different rule, namely the discovery rule."

Just a few months later, in *Psihoyos v. John Wiley & Sons*, 2011 WL 4916299, \*5 (S.D.N.Y. Oct. 14, 2011), Judge Jed Rakoff of the Southern District reiterated that the

“discovery” rule applies:

[A]ccording to the Second Circuit's opinion in *Stone v. Williams*, 970 F.2d 1043 (2d Cir.1992), **the statute of limitations in copyright infringement cases runs from the time plaintiff discovers the infringing use.** *Id.* at 1048 (emphasis added). *TRW [v. Andrews]*, 534 U.S. 19, 122 S.Ct. 441, 151 L.Ed.2d 339 (2001)] did not change this. Indeed, the Supreme Court's holding in *TRW* was not as broad as defendant asserts, and applies only where Congress expressly states that the statute of limitations runs from the date on which the liability arises. *TRW, Inc.* 534 U.S. at 28. No such congressional instruction appears in section 507(b).

Defendant cites *Auscape Int'l v. Nat'l Geographic Soc.*, 409 F.Supp. 2d 235 (S.D.N.Y. 2004) (“*Auscape*”), wherein Judge Kaplan held that the statute of limitations is triggered by the date of the infringement (“the injury rule”). However, *Auscape* seems to be abandoned both in the Southern District and generally. The First, Third, Fourth, Sixth, Eighth, and Ninth Circuits all apply the discovery rule. *See Beidleman v. Random House, Inc.*, 621 F.Supp. 2d 1130, 1133-34 (D. Colo. 2008) (citing cases). The Third Circuit explicitly rejected *Auscape*, and the Supreme Court has not taken up the question. *See William A. Graham Co. v. Haughey*, 568 F.3d 425, 434-35 (3d Cir. 2009) (*cert. denied*, 130 S.Ct. 503). The discovery rule is all that remains.

A reasonably diligent person in Dr. Lang’s position would have been put on inquiry notice as to the existence of Ms. Morris’s infringement as of April 2, 2009, the date he received an email alerting him that Ms. Morris had created paintings from some of his crease patterns, which he confirmed upon researching the matter. Under the discovery rule, applied by Second Circuit in *Stone v. Williams* and the majority of courts in the country, this is the date his claim accrued, and all of Plaintiffs’ claims are timely.

Mr. Miyajima learned of Ms. Morris’s infringements of his work not earlier than April 4, 2009, and Mr. Ku in December 2010. Even ignoring the prior case in Northern California, filed March 22, 2011, the instant action was filed December 5, 2011, less than three years after the earliest date of discovery. Plaintiffs exercised reasonable diligence in policing their work and prosecuting their claims after discovery of the violations.

### **C. Principles of Equity Prevent the Application of the Statute of Limitations.**

Aside from the issue of whether the discovery rule applies to this case, there are

adequate grounds for equitable tolling for a period sufficient to defeat Defendant's claim that the statute of limitations has run. *See L.A. Printex Industries, Inc. v. At Last Sportswear, Inc.*, 2009 WL 1285923 (S.D.N.Y. May 4, 2009). "A decision whether to equitably toll a statute of limitations is left to the sound discretion of the district court." *Kregos v. Associated Press*, 3 F.3d 656, 661 (2d Cir. 1993). Equitable tolling is appropriate "where necessary to prevent unfairness to a plaintiff who is not at fault for her lateness in filing." *Veltri v. Building Serv. 32B-J Pension Fund*, 393 F.3d 318, 322 (2d Cir. 2004).

The *Auscape* decision itself noted the significance of the court's discretion in equitably tolling the statute of limitations for copyright infringement. *See Urbont v. Sony Music Entm't*, 2012 WL 1034905 at \*6 (S.D.N.Y. Mar. 27, 2012) (citing *Auscape*, 409 F.Supp. 2d at 246-47.) And courts have indeed "continued to allow for the possibility of equitable tolling in the context of infringement claims," "as Congress had hoped." *Id.* (citing *Broadvision*, 2009 WL 1392059, at \*6-7; Melville B. Nimmer & David Nimmer, 4 *Nimmer on Copyright* § 12.05[B][3] (2011)).

Here, Plaintiffs' diligence in discovering harm and taken action, Plaintiffs' timely filing of their claims in the Northern District of California, and Defendant's fraudulent concealment of her acts of infringement are all strong grounds for tolling the statute of limitations.

**1. The Court Should Toll the Statute From the Date Plaintiffs' Filed Suit in the Northern District of California.**

On March 22, 2011, Plaintiffs filed an action in the Northern District of California for the same claims appearing in the December 5, 2011 Southern District of New York Complaint. The Court should find the statute of limitations was equitably tolled by the filing of the California action, which put Defendant on notice of the claims she would be called upon to defend.

The facts of *L.A. Printex Industries v. At Last Sportswear, Inc.*, 2009 WL 1285923 (S.D.N.Y. 2009), are remarkably similar to the case at bar. The plaintiff brought suit in a California district court in 2008, at which point the statute of limitations had not run under any rule. *Id.* at \*1-2. The court ultimately determined that

it lacked personal jurisdiction over the defendant. *Id.* at \*1. The plaintiff then filed its action in the Southern District of New York, where the defendant conceded that it was subject to personal jurisdiction, three weeks later—“a span of time that suggests reasonable diligence.” *Id.* at \*2 (citing *Abbas v. Dixon*, 480 F.3d 636, 642 (2d Cir. 2007) (noting that “[d]ue diligence on the part of the plaintiff in bringing an action . . . is an essential element of equitable relief”)).

In *L.A. Printex Industries*, Judge Rakoff found the statute of limitations was equitably tolled during the time the California action was pending. *Id.* Similar to here, the plaintiff could have sought a transfer rather than a dismissal of the action, which could have avoided the statute of limitations problem; however, Judge Rakoff “[did] not see this oversight as reason to deny plaintiff equitable tolling,” remarking that “Defendant has been on notice since at least May 15, 2008 that it will be called upon to defend against plaintiff’s lawsuit and cannot claim that it suffers any prejudice as a result of plaintiff’s actions.” *Id.* (“As the Supreme Court has noted, ‘[w]hen a lawsuit is filed, that filing shows a desire on the part of the plaintiff to begin his case and thereby toll whatever statutes of limitation would otherwise apply.’”) (citing *Goldlawr, Inc. v. Heiman*, 369 U.S. 463, 467 (1962)).

Here, Plaintiffs filed suit in the Northern District of California on March 22, 2011. (Supp. Jacobson Decl., Ex. K, Dkt. 1.1, Civil Cover Sheet.) Judge Chen granted Ms. Morris’s motion to dismiss for lack of personal jurisdiction on October 26, 2011. (Supp. Jacobson Decl., Ex. L, Dkt. 38.), but the case was not closed until December 6, 2011, after Judge Chen denied Defendant Morris’s meritless motion for attorney’s fees, which Judge Chen denied on December 6, 2011; he closed the case with that order. (Supp. Jacobson Decl., Ex. M, Dkt. 49. Plaintiffs had filed the instant action in the Southern District of New York the day before, on December 5, 2011. *L.A. Printex Industries* provides that plaintiffs should not be penalized for making litigating the issue of jurisdiction in California.

Plaintiffs acted diligently to pursue their claims in the Southern District of New York. Defendant Morris was aware that the same claims would be prosecuted in New



York, and suffered no prejudice that would obviate the appropriateness of equitable tolling in this case. The court should equitably toll the statute of limitations as of March 22, 2011, and apply the discovery rule, the prevailing rule of accrual in the majority of circuits; in such case, all of Plaintiffs' claims are timely.

If, for the sake of argument, the Court instead equitably tolls the statute of limitations as of March 22, 2011, and applies the injury rule, this would bar works not infringed after March 22, 2008. Most of Plaintiffs' works were infringed within that time frame, including multiple crease patterns Dr. Lang published in *Origami Design Secrets*; the two crease patterns Dr. Lang published on his website; Mr. Ku's crease pattern Harpy; and all but two of Mr. Miyajima's crease patterns asserted in the original California and New York complaints (excluding Bat and Mommoth).<sup>3</sup>

**2. The Court Should Toll the Statute Based on Defendant's Deliberate Concealment of Her Wrongdoing.**

A separate basis for equitable tolling exists because Ms. Morris deliberately concealed information that could have led Plaintiffs' actions to accrue earlier, through putting them on notice of the infringements. "Read into every federal statute of limitations . . . is the equitable doctrine that in case of Defendant's fraud or deliberate concealment of material facts relating to his wrongdoing, time does not begin to run until plaintiff discovers, or by reasonable diligence could have discovered, the basis of the lawsuit." *Barrett v. U.S.*, 689 F.2d 324, 327 (2d Cir. 1982) (internal citation omitted).

Where a defendant has engaged in deliberate or fraudulent concealment of injury to the plaintiff, the limitations period is tolled until the plaintiff discovers the deceitful conduct or the facts giving rise to the cause of action. Accrual of the action is deferred because an infringer will not be permitted to avoid liability by concealing wrongdoing until the limitations period has run. The Second Circuit explained that "any plaintiff who is blamelessly ignorant of the existence or cause of his injury should be accorded the

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<sup>3</sup> Plaintiffs have not had the opportunity to conduct discovery on the additional claims related to Mr. Miyajima's crease patterns Lion and Raccoon Dog, which the proposed First Amended Complaint would add.

benefits of the more liberal accrual standard”—i.e., the “diligence-discovery rule.” *Peck v. United States*, 470 F.Supp. 1003, 1018 (S.D.N.Y. 1979). Consequently, Plaintiffs’ causes of action accrued when they discovered or should have discovered the critical facts of the infringement.

None of these Origami Artists knew or had reason to know of Ms. Morris’s copying and distribution of their works prior to April 2009, largely because she lied about the origins of her source material. Ms. Morris’s deceit is publicly documented. She falsely claimed in multiple interviews and publications that her works were based on “found” origami designs, (Supp. Jacobson Decl., Ex. N, showing the press release for Morris’s “Lesser Panda” exhibition at the White Cube Gallery in London in 2008 (D000783), implying that the designs were traditional origami designs, hundreds of years old.

Ms. Morris and her assistants “found” those crease patterns in the sense that Christopher Columbus “found” the New World. While ignoring the inconvenient fact that there was a preexisting owner, she and her assistants copied crease patterns from books and websites that bore clear author attribution and sometimes copyright notices.

That Ms. Morris invoked Dr. Lang’s name in promoting her Origami series, while hiding that she had copied his crease patterns for some of the works in that series, reveals her bad faith. That she also, in the same interviews, claimed that the crease patterns were “found” designs, constitutes a deliberate effort to mislead. (See Morris Decl., Exh G.) Her carefully constructed presentation about her work was intended to obfuscate the reality about her source materials.

Defendant misleadingly cites Plaintiffs’ deposition testimony in an attempt to argue that her use of the terms found and traditional when applied to the crease patterns she copied did not hinder their searches for Morris’s works infringing their copyrights. At the portion cited, Ku discussed not being deterred by the term “found diagram” in the search he conducted **after** learning Ms. Morris had been infringing the work of other artists. (Jacobson Decl., Ex. C, Ku Tr. 126:4-12.) Ku also discussed how he compared the image of Ms. Morris’s painting Angel that he received by email to his Harpy crease

pattern and determined she had copied his work. (*Id.*, Ku Tr. 144:13-20.) Lang likewise explains that once he already had visual proof that Ms. Morris's had copied his work, he was not deterred by her use of the term "found designs," etc. Lang Tr. 276-277.

In January 2008, after apparent notice from her counsel, Ms. Morris began to change the titles of some of her paintings so they were no longer the same as the crease patterns on which they were based. (Supp. Jacobson Decl., Ex. O, D000860. For example, her assistant announced in an email to White Cube Gallery that Morris had changed the titles of four paintings—all based on Dr. Lang's crease patterns. (Supp. Jacobson Decl., Ex. P., D002548). She delayed the Origami Artists' discovery of the infringements in that she not only avoided identifying them as the authors of the crease patterns, she deliberately lied about the fact that she copied modern crease patterns from contemporary origami artists. Supp. Jacobson Decl., Ex. Q, D000783, press release for Lesser Panda exhibition.

Had Ms. Morris truly believed her works to be fair use of Plaintiffs' crease patterns not implicating copyright, she could have been honest about the source. Given the false claims that Ms. Morris's works were based on found (meaning "ownerless") and "traditional" crease patterns, the Origami Artists—who create original, modern origami designs—were deprived of notice of the possibility that she was infringing their works.

The Origami Artists, under the circumstances, would not reasonably be expected to discover the infringement any earlier than they did. Because Morris lied about the sources and authorship of the crease patterns she used to create her work, the Court should hold that the statute started to run no earlier than when Dr. Lang first discovered he had a basis to pursue infringement claims against Ms. Morris, on April 2, 2009.

#### **IV. DR. LANG IS ENTITLED TO STATUTORY DAMAGES**

##### **A. Morris Sold Works Infringing *Origami Design Secrets* Less Than Three Years Before This Action Was Filed.**

Even under the most restrictive application of the accrual date for Plaintiffs' claims, Dr. Lang would be entitled to seek statutory damages for infringements of at least two of his works.

Ms. Morris produced uncontradicted evidence in discovery supporting an

inference that she sold two works based on crease patterns Dr. Lang published in *Origami Design Secrets* within three years prior to December 5, 2011, the date Plaintiffs filed the New York Complaint. The Court should therefore find that the evidence favors Plaintiffs here and should award Dr. Lang statutory damages for Ms. Morris's infringement of *Origami Design Secrets*. The two works in question are:

- (1) A painting titled Dragon [Origami] ("Dragon");
- (2) one of three paintings called Calypte Anna [Origami], a work likely measuring 122 cm x 122 cm ("Calypte Anna 122").

### **1. The Sale of Dragon**

It is undisputed that in 2007, Ms. Morris produced a painting titled Dragon based on Dr. Lang's crease pattern KNL Dragon. Although Ms. Morris responded to an interrogatory propounded by Dr. Lang that the painting had not been sold, this was contradicted by documents she produced.

On May 31, 2012, prior to the close of discovery, Plaintiff's counsel alerted Ms. Morris's counsel via email to the discrepancy regarding the status of Dragon and received no answers. Plaintiffs' counsel again raised the issue by letter on August 9, 2012. (Supp. Jacobson Decl., Ex. R, letter August 9, 2012). Ms. Morris responded by producing a copy of an invoice for a 2007 sale of Dragon and a "subsequent credit issued by the gallery on 19/12/2008 [Dec. 19] showing that the sale of this piece was cancelled."

Ms. Morris fails to address the fact that, according to other documents she produced, Dragon was again sold in 2009. Graham Steele of White Cube Gallery informed Morris of the sale in an email exchange dated June 1, 2009. (Supp. Jacobson Decl., Ex. S, D000462). In an email dated June 18, 2009 that Ms. Morris sent to her own email address, apparently for tracking purposes, she lists Dragon under the heading: "WHITE CUBE NOT INVOICED IN STATEMENTS, BUT SOLD." (Supp. Jacobson Decl., Ex. T, D002196).

This sale is significant not only for purposes of calculating damages, but for statute of limitations purposes. The sale constitutes a separate act of copyright infringement occurring after Dr. Lang contacted Ms. Morris about her apparent

infringements of his works. Plaintiffs filed suit in the instant action less than two-and-a-half years after this sale, entitling Dr. Lang to seek statutory damages as a remedy for this infringement.

## 2. The Third Calypte Anna

Ms. Morris admits that she produced two paintings based on Dr. Lang's Hummingbird crease pattern, published in *Origami Design Secrets*—Calypte Anna 214 and Calypte Anna 289.<sup>4</sup> Ms. Morris produced documents in discovery showing that she agreed to produce a third Calypte Anna painting on commission. (Supp. Jacobson Decl., Ex. U, D000617-18.) Other documents produced indicate the diagram had been resized for a 122 cm work but had not been completed by November 2008. (Supp. Jacobson Decl., Ex. V, D000612, D002398-99, D000633-634).

After Ms. Morris omitted the Calypte Anna 122 from her list of works at issue (*see* Ex. A to the Decl. of Sarah Morris, Dkt. 53-1), Plaintiffs' counsel requested that she comply with her ongoing duty under Rule 26(e) by producing documents related to the sale. Supp. Jacobson Decl. Ex.R. The response provided by opposing counsel on August 22 avoids unequivocally denying that she had created the painting: "it *appears* that the work you refer to as 'a 122 cm x 122 cm version of Calypte Anna' was never in fact produced. Defendant's records, and those of her galleries, show *no record* of any such piece ever actually being made." *Id.* (emphasis added.)

The absence of a record of the work's completion is not dispositive, especially given that Ms. Morris by her own admission does not have all documents related to each work. In her deposition, when asked about her studio's process for keep records, Ms. Morris responded:

Well, like any artist's studio, it's whatever the process is. I'm sort of amazed that we have stuff as thoroughly as we have. I mean stuff goes -- you know, it's not, by any means, a science lab or anything as organized as that. . . . Some things, you know, I apologize if sometimes some things are there and some things are not; but anyway, that's sort of what happens.

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<sup>4</sup> Morris initially titled the 214 cm work Hummingbird, then changed the name to Calypte Anna in February 2008, prior to producing the 289 cm work. Supp. Jacobson Decl., Ex. P.)

(Morris Depo. 148:20-25; 149:12-15.)

When asked whether notebooks were kept for specific works, Morris stated:

No, they are kept, like the [R]ing paintings, the Origami series would probably all be together and basically you know the photographs of the finished artwork would be possibly there and any process documents we have would be -- would be there. And we Xeroxed everything in those books for you.

(Morris Depo. 150:24-151:7.)

As the emails show the Calypte Anna 122 was directly commissioned and likely would have been shipped directly to the apparently U.S.-based collectors. Furthermore, in a December 2009 email from Morris's assistant to Graham Steele at White Cube Gallery, she states "sometimes important information [is] missing from the account statements, such as the size of artworks sold and to whom it was sold." (Supp. Jacobson Decl., Ex. \_\_ - D000627) (*also see* D001732 – email from Morris: "both the July and August accounting statements for parallax do not include invoicing to air de paris for paintings reported sold as of June!")

There is sufficient evidence to support an inference that this painting was produced less than three years prior to December 5, 2011, making Lang eligible for statutory damages for the infringement.

## **V. MORRIS'S COPYING OF PLAINTIFFS' WORK WAS NOT FAIR USE**

Ms. Morris tries to persuade the Court that Plaintiffs' crease patterns are not artistic, but mere educational diagrams with a functional purpose. Defendant is obliged when making such an argument to refrain from using Plaintiffs' deposition testimony out of context. Neither Dr. Lang, Mr. Miyajima, nor Mr. Ku have conceded that the only purposes of their crease patterns are functional and instructive. They each discussed the aesthetic choices they made in creating the crease patterns at issue.

### **A. Plaintiffs' Crease Patterns Are Original Works of Authorship Deserving Copyright Protection**

Defendant constructs an argument where there is none regarding the purpose of origami crease patterns. An origami crease pattern *can* be viewed as proof that a given model was folded from a single sheet of paper; a crease pattern *may* also offer guidance in folding an origami model. But as each plaintiff testified, these are not the only

purposes of their crease patterns. Plaintiffs testified clearly and insistently that their crease patterns have an artistic purpose and meaning. These artists deliberately consider the aesthetic implications of the design choices they make. In fact, Dr. Lang talked at length about the aesthetic goals of his crease pattern design process, separate from the relationship of the crease pattern to the folded model. Dr. Lang explained throughout the deposition that he designed the crease patterns at issue to be elegant and aesthetically pleasing:

Q. So [creating a crease pattern is] a means to an end. It's a means to having your folded model turn out the way you want it to turn out.

A. I wouldn't -- I wouldn't say that. It is -- because it is a part of the model, it's part of the process, I want the crease patterns themselves to be interesting, to have beautiful structure. And so when I'm creating the design, I want parts in the right place to fold, but I also want this pattern to be lovely and interesting and not simple, not too repetitive.

(Lang Depo. 59:4-14, attached to the Supp. Jacobson Decl., Ex. A.)

Mr. Clarida repeatedly attempted and failed to extract a concession from Dr. Lang that his crease patterns have a purely functional purpose. He failed because the premise is faulty:

Q. So you're not concerned yourself with aesthetics when you're doing this.

A. I'm very concerned with aesthetics.

Q. Oh, I thought you said you can't tie whether it looks nice with what I'm doing here on this page.

A. I'm trying to develop an elegant crease pattern here and elegance is an aesthetic property.

(Lang Depo. 61:10-16.)

Lang also described why a crease pattern is not simply a folding instruction for an origami model:

[I]t depends on the design, but typically there are many folds that are essential to the design that are not represented in a crease pattern. And so without some form of guidance outside of the crease pattern you wouldn't be able to make those additional folds.

(Lang Depo., 91:22-92:4.)

Dr. Lang repeatedly reminded Mr. Clarida as they discussed the meaning and purpose of individual crease patterns that he designs each of his works to be aesthetically pleasing:

Q. In addition to the purposes that we've talked about for these other crease patterns—guide to folding, proof certificate, insight into structure, so on, does this

crease pattern have any other particular purpose?

A. I think I guess this crease pattern and really all of the others have a goal of a little bit of showing off. I think, I think my patterns are beautiful and I want to show them off.

(Lang Depo., 182:19-183:4.)

Defendant startlingly resorts to denigrating the artistic value of crease patterns based on their connection to *mathematics*. The fundamental relationship between art and mathematics was recognized by the ancient Greeks and Egyptians. “[M]athematics and painting are so closely related and have so many similarities that it is reasonable to consider them simply as two different but complementary ways of visualising aspects of the concrete or abstract reality in which we are embedded.” Jensen, H.J. “Mathematics and painting,” *Interdisciplinary Science Reviews* (2002), Vol. 27, No. 1 at 45.<sup>5</sup> Ms. Morris is aware that mathematical concepts are of critical importance to both the creation and the response by the viewer to her own work. (See Def.’s Statement of Undisputed Facts (Dkt. 49), ¶ 66: “Color, and its relationship to geometry, is central to Morris’s work.”) Thus, the connection between origami and mathematics in no way supports Defendant’s argument that crease patterns lack value as creative expressions.

Defendant cites *MiTek Holdings, Inc. v. Arce Engineering Co., Inc.*, 89 F.3d 1548, 1557 n.20 (11th Cir. 1996), as support for the notion that “copyright protection for crease patterns is at the weaker end of the scale.” (Dkt. 34 at pg. 7.) That case, addressing the copyrightability of nonliteral elements of a computer program, has nothing to say about the copyrightability of crease patterns.

Copyright protects originality “of intellectual production, of thought, and conception on the part of the author,” *Burrow-Giles Litho. Co. v. Sarony*, 111 U.S. 53, 58, 60 (1884), without preferring one type of art over another, see *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 581 (1994) (“[t]he Act has no hint of an evidentiary preference for parodists over their victims”). If Plaintiffs had unfolded

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<sup>5</sup> Available at [www.gsjournal.net/h/papers\\_download.php?id=804](http://www.gsjournal.net/h/papers_download.php?id=804). Also see <http://virtualmathmuseum.org/mathart/MathematicalArt.html>; Taylor & Francis also publishes the *Journal of Mathematics and the Arts*, as seen here: <http://www.tandfonline.com/toc/tmaa20/current>.



origami models and photographed the lines left on the paper by folding the model, these photographs would be protected by copyright. *See, e.g., Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (noting that copyright protects photographers' creative choices in making an image).

Published crease patterns are works of original authorship fixed in a tangible medium. There is sufficient evidence that each Infringed Work qualifies for copyright protection as an original, expressive work of authorship. Each of these graphic images was the product of the creative, independent effort of its author, who selected which material to include or omit, and the color, size, and arrangement of that material. *See, e.g., Lang Opp. Decl.*, ¶ 12; *Supp. Jacobson Decl., Ex. A*; *Lang Tr.*, Transcript of Ku Deposition, *Supp. Jacobson Decl., Ex. C*, 42:17-43-6; *Supp. Jacobson Decl., Ex. B*, Transcript of Miyajima Deposition, 30:7-31:11.

**B. A Different Purpose Does Not Make a Work Transformative**

Both the crease patterns Ms. Morris infringed and the Infringing Works she created all have the purpose of being visually experienced and appreciated by the viewer, potentially sparking a reaction, association, or contemplation. As works of visual art, they all have the potential to grace the walls of homes, art galleries, or museums. Dr. Lang has been selling, licensing, and exhibiting crease patterns for artistic purposes for over ten years. (*See, e.g., Lang Opp. Decl., Ex. A.*) Ms. Morris's assertion that she put her works to a different purpose is in any case insufficient, because putting a copyrighted work to a different purpose does not make the use transformative. *Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104, 108 (2d Cir. 1998) ("difference in purpose is not quite the same thing as transformation").

Nor does physically "transforming" the works of another, such as by changing the medium, offer shelter from liability. *See, e.g., Rogers v. Koons*, 751 F. Supp. 474, 477 (S.D.N.Y. 1990), *aff'd*, 960 F.2d 301 (2d Cir. 1992); *see also Blanch v. Koons*, 467 F.2d 244, 252 (2d Cir. 2006) ("We have declined to find a transformative use [under Section 107] when the defendant has done no more than find a new way to exploit the creative virtues of the original work.").

As the Second Circuit has noted, a work might “recast, transform, or adapt an original work into a new mode of presentation,” thus making it a derivative work under 17 U.S.C. § 101, without being “transformative” in the sense of the first fair use factor. *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, 150 F.3d 132, 143 (2d Cir. 1998). Such is the case here.

**C. Morris Created Unauthorized Derivative Works From Plaintiffs’ Crease Patterns**

Morris claims to have used the Infringed Works as her “launching pad,” but she never achieved take-off. Alterations to the original designs, if there were any, were minor and not connected to any supposed commentary. (See Jacobson Declaration, Ex. N, 4/9/2009 email of Sarah Morris: “Wolf . . . was only the second origami painting and therefore not changed at all from the original;” see also Jacobson Decl., Ex. T: “maybe a few more horizontal lines that make skinny sections like rockhopper.”) Whatever the difference in scale, the Infringing Works all retain the essence of the original, but the issue of size is a red herring.

Ms. Morris produced as many as four different sizes of drawings and paintings based on individual crease patterns; using the same design, she scaled up or down, depending on the goal. (See Morris’s list of works and sizes at pg. 2, Dkt. 53-1.) For example, in 2007, she produced a Rockhopper painting that was 122 cm (about 4 feet) on each side and a drawing based on the same design, that was about 21 cm (about eight inches) on each side. Then she produced a Rockhopper painting, 289 centimeters on each side (over nine feet) and had an edition of silkscreen prints measuring 20.8 cm on each side printed for sale.

She and her assistant copied the graphic images, then reproduced them on a larger scale by imitating the lines and angles and their arrangement, retaining the square frame of the original. Ms. Morris’s studio assistants then transferred the designs to paper or canvas, with careful attention to the angles. The type of “transforming” involved here—scaling up graphic images and painting or drawing them—resulted in nothing more than derivative works. *See Rogers*, 751 F. Supp. at 477; *see also* H.R. Rep. 94-1476, 1976 U.S.C.C.A.N. 5659, 5675 (1976) (“[A] copyrighted work would be

infringed by reproducing it in whole or in any substantial part, and by duplicating it exactly or by imitation or simulation. Wide departures or variations from the copyrighted work would still be an infringement as long as the author's 'expression' . . . [is] taken.”).

Dr. Lang and other origami artists have also created and displayed large versions of their crease patterns (derivative works) in museums and galleries. (Lang Opp. Decl., Ex. A.) Four of Dr. Lang's crease patterns are installed in a roadway intersection in Santa Monica. (*Id.*)

Ms. Morris took the essence of the Origami Artists' work—as demonstrated by the fact that Dr. Lang was first alerted by a third party who recognized Dr. Lang's work when viewing photos of Ms. Morris's paintings. Plaintiffs do not dispute the fact that Ms. Morris made significant alterations to some crease patterns she copied—but this is not the case for the works at issue. The Infringed Works were copied almost verbatim. Morris's assistant admits in an email that there were *no alterations* to the initial crease patterns copied, including Wolf. (Jacobson Decl., Ex. N.) Morris could have made substantial changes to the Infringed Works after copying them, as she eventually did for her large origami walls murals (see Jacobson Decl., Ex. V), which are transformative and not part of this case. But she was too lazy to transform the works at issue here.

#### **D. Morris Displayed Bad Faith**

In addition to the examples of bad faith Plaintiffs raised in their Motion for Summary Judgment, there is another way that Ms. Morris demonstrated her ill intentions. Out the outset of negotiations in this case, Defendant mistakenly argued that Plaintiffs would not have a claim to income derived from foreign sales of the Infringing Works. Thus, in an email dated April 9, 2011 (after Plaintiffs filed suit in California), Morris's assistant instructs that the painting Rockhopper, which was to be consigned to German gallery Fredrich Petzel, “should not be shipped or sold in the US.” (Supp. Jacobson Decl., Ex. W, D000276.) Ms. Morris reveals she did not intend to discontinue her activities pending resolution of Mr. Miyajima's claim that Morris had infringed his Penguin crease pattern, so she could ensure he did not have the proceeds.

**CONCLUSION**

Morris did not bring the crease patterns into the art realm—she merely copied them into unauthorized derivative works from Plaintiffs’ copyrighted works, which she distributed through sale, donation, publication, and exhibition. The fair use defense is no help to an infringer in Morris’s shoes. Moreover, the Court should toll the statute of limitations for equitable reasons, and allow Plaintiffs to maintain their claims against Morris.

For the reasons set for the above, the Court should deny the Defendant’s Motion for Summary Judgment.

Dated: September 10, 2012.

Respectfully submitted,

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